APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,087	05/31/2006	Kazuhiro Kusuda	5132-0103PUS1	2056

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EXAMINER
LIM, SENG HENG

ART UNIT	PAPER NUMBER
3717	

NOTIFICATION DATE	DELIVERY MODE
04/27/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

	Application No.	Applicant(s)
Office Action Summary	10/581,087	KUSUDA ET AL.
	Examiner	Art Unit	
	SENG H. LIM	3717	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>12 April 2011</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-30</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-22</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>23-30</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>07 March 2011</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ ~~Notice of Draftsperson's Patent Drawing Review (PTO-948)~~

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/7/2011 has been entered.

Response to Amendment

This office action is in response to the amendment filed on 3/7/2011 in which applicant amends claims 23-24 & 30; and responds to the claim rejections. Claims 1-30 are pending. Claims 1-22 were withdrawn.

Response to Arguments

Applicant's arguments with respect to claims 23-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 30 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Further, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. A program that has the intended use of being used in a computer system is nonstatutory because it must be claimed as part of a computer system.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein
were made absent any evidence to the contrary. Applicant is advised of the obligation
under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was
not commonly owned at the time a later invention was made in order for the examiner to
consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)
prior art under 35 U.S.C. 103(a).

Claims 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Tajiri et al (US 6,482,092 B1) in view of Gress (US 2005/0151320 A1) and Itou et al (US
6,354,940 B1).

Re claim 24. Tajiri discloses a game machine which performs a multiplayer
competition game in which a plurality of players compete [with] each other for capturing
characters (Fig. 5-7), comprising:

a communication interface (30 & 31: Fig. 2) for transmitting and receiving data to
and from another game machine (col. 2, lines 24-25, Fig 5-7),

an operation unit (23: Fig. 2) with which a player performs input operation of
signals; and

a display unit (27: Fig. 2) for displaying the situation of the game;

a storage unit (10B) for storing data representing a plurality of types of
characters, each provided with a different property (col. 13, lines 51-54, Fig. 3);

an extraction unit (23: Fig. 2) for extracting, triggered by the player's selecting
operation, data representing a predetermined number of characters (col. 13, lines 46-
54);

a party formation unit (23: Fig. 2) for generating data representing a party consisting of each of said characters, by combining the data representing said extracted characters (i.e. battle data, col. 13, lines 46-54); and

a game performing unit (23: Fig. 2) for performing a multiplayer competition game in which an offensive of one party causes a total physical strength value of the other party to become a value equal or lower than a predetermined value and thereby determines a winner and a loser (L38 & L42: Fig. 20), using said data representing said formed party, and data representing the party input from said another game machine (i.e. battle between main player and rival trainer, col. 13, lines 41-45).

Tajiri also discloses the concept of capturing a defeated pokemon during a battle and adds it to his collection (col. 10, lines 1-9). Tajiri does not expressly disclose defeating another game machine in the competition and capturing the another game machine's character; however, the concept of capturing the defeated opponent's character of another game machine is known as evidenced by Gress [0078]. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Tajiri in view of Gress to capture opponent's defeated character and would have been motivated to do so to increase the excitement of the game by increasing the incentive of winning a battle.

Tajiri does not expressly disclose wherein said game performing unit transfers the data which is stored in association with said client device of a side defeated in said competition and which represents any one of the characters configuring said party, together with its remaining number of times available, and stores said data and said

remaining number of times available in association with said client device of the side
which wins said competition; however winning/receiving a character together with its
remaining number of times available to the winner of a competition is known in the art
as evidenced by Itou et al (col. 5, lines 13-17 & line 65 – col. 6, line 8). At the time of
with Itou and would have been motivated to do so increase interaction of players and
the ability to exchange characters among the players.

Re claim 23. Tajiri, Gress and Itou disclose a game machine comprising a
plurality of client devices and communication interface for transmitting and receiving
data to and from another game machine as discussed in claim 24 above. Itou also
discloses that it's known to conduct multiplayer game over a server device (col. 4, lines
53-56, Fig. 1).

Re claim 25. Tajiri discloses the remaining number of times available of the
character configuring said party is decreased by a certain number if it is defeated in said
competition, whereas the character and its remaining number of times available added
to the side which won said competition is approximately equal to said decreased
number of times available of the character (col. 13, lines 41-64).

Re claim 26. Gress disclose the data representing any one of the characters
configuring said party is deleted upon losing said competition, whereas the character
and its remaining number of times available added to the side which won said
competition are approximately equal to said deleted character (i.e. after capturing the
opponent's character, the opponent's character is implicitly deleted from the opponent's
data).

Re claim 27. Gress disclose the party formation unit newly generates, when performing the next game, data representing said party, using the data representing said character and its remaining number of times available (i.e. the captured character can be used by the winning player in following games).

Re claim 28. Gress disclose the extraction unit disables, at the next and subsequent games, extraction of at least one of the data representing the character and its remaining number of times available, which together compose the data representing the party used when performing said game (i.e. the opponent that losses it's character can no longer extract that character's data).

Re claim 29. Tajiri discloses the storage unit stores a plurality of types of tables including data representing a plurality of types of characters, each of which is provided with a different property, and data of a plurality of types of symbols which are determined in association with the data representing each of said characters and can be displayed on said display areas (Fig.3),

said party formation unit associates, for each of display areas, said data representing said characters (Fig. 20),

said display unit reads said table corresponding to the data representing said characters, and performs, on said display areas associated with the data representing said characters, a varying state presentation in which a plurality of symbols having been in their halted state on a plurality of display areas are constantly varied into a variety of symbols and displayed, and a halted state presentation in which said symbols being

presented in the varying state are halted again and displayed on each of said display areas (Fig. 3 & 20).

Re claim 30. Tajiri, Gress and Itou disclose a game program (Tajiri, col. 6, lines 11-29) for performing a multiplayer competition game as discussed in claim 24 above.

Filing of New or Amended Claims

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See Wertheim, 541 F.2d at 263, 191 USPQ at 97 ("[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."). However, when filing an amendment an applicant should show support in the original disclosure for new or amended claims. See MPEP § 714.02 and § 2163.06 ("Applicant should specifically point out the support for any amendments made to the disclosure."). Please see MPEP 2163 (II) 3. (b)

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SENG H. LIM whose telephone number is (571)270-3301. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on 571-272-4709. The fax phone

number for the organization where this application or proceeding is assigned is 571-
273-8300.

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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/

Supervisory Patent Examiner, Art Unit 3717

/S. H. L./

Examiner, Art Unit 3717